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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/190,993	11/12/1998	CRIS T. PALTENGHE	CITI0094-US	8143

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KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
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WASHINGTON, DC 20005

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/190,993
Filing Date: November 12, 1998
Appellant(s): PALTENGHE ET AL.

Mr. George T. Marcou
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 October 2002.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

Applicant stated in the brief that there are no related appeals.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant made no statement in the brief regarding the status of amendments after final rejection. The amendment after final rejection filed on 08 May 2002 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant indicated in the brief that claims 14-24 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,016,484	Williams et al	1-2000
5,744,787	Teicher	4-1998
5,903,880	Biffar	5-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Williams et al*, U.S. Patent No. 6,016,484 in view of *Teicher*, U.S. Patent No. 5,744,787.

As per **Claim 14**, *Williams et al* discloses a virtual wallet system comprising a locally residing wallet portion, an external server residing wallet portion and further discloses exchanging first data from a local portion of the wallet into a point of sale device wherein the first data includes a transactional amount (Col. 11 lines 59-67; Col. 12, lines 46-50; Col. 12 line 66-Col. 13 line 17; Col. 14, lines 5-25; Col. 16, lines 34-54). *Williams et al*, however, fails to specifically disclose synchronization between the local and server portions of the wallet by receiving and storing at the server portion an electronic voucher indicative of the good purchased and receiving a request for the electronic voucher at the server portion and providing the good to a user. *Teicher* discloses a system and method for making purchases with an electronic wallet that includes a local wallet portion and an associated server portion at a financial institution and teaches receiving and storing at the server portion an electronic voucher indicative of the purchase and receiving a request for the electronic voucher at the server portion of the wallet (Col. 7 line 60-Col. 8 line 3; Col. 8, lines 9-14; Col. 9, lines 21-30; Col. 10, lines 3-8 and 15-32) and providing the good to a user upon receipt of the electronic voucher (Col. 11, lines 57-65). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Williams et al* and include the steps of synchronizing the local and server portions of the electronic wallet as taught by *Teicher* so that central accounts associated with the local electronic wallet can be debited for purchases made off-line with the local electronic wallet.

As per **Claims 15-20**, *Williams et al* further discloses wherein the wallet includes payment mechanisms such as bank account information, electronic currency, credit card and debit card information (Col. 15, lines 32-49); identity authentication mechanisms such as personal identification information and authentication information including certificates (Col. 15, lines 32-67 and Col. 37 lines 45-63); and wherein personal information comprises name and address information (Figures 15 and 29).

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As per **Claim 21**, *Williams et al* further discloses a virtual wallet system wherein the electronic artifacts include loyalty programs and coupons (Col. 19, lines 50-55).

As per **Claim 22**, *Williams et al* further discloses wherein the external server residing portion includes a mirror of information contained on the locally residing wallet portion (Col. 11, lines 35-56).

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Williams et al*, U.S. Patent No. 6,016,484 and Teicher, U.S. Patent No. 5,744,787 as applied to claim 14 above, and further in view of *Biffar*, U.S. Patent No. 5,903,880.

As per **Claims 23 and 24**, *Williams et al* and *Teicher* fail to specifically disclose wherein the external server residing portion includes applications and the locally residing wallet portion comprises connectors to the applications that reside on the external server residing portion. *Biffar* discloses a system that creates and transfers digital vouchers and includes remote devices such as smart cards and a central server system (Col. 6, lines 33-39 and Col. 8, lines 18-40). *Biffar* also discloses that the remote devices include a memory portion for storing vouchers or the user can store some or all of the user's vouchers in an account on an external server (Col. 8, lines 60-67) and the user has the capability to establish contact with the external server and utilize applications to perform a number of different functions regarding the accounts (Col. 8, lines 1-18 and Col. 8 line 64-Col. 9 line 34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the external server application features taught by *Biffar* into the system of *Williams et al* and *Teicher* as this feature would enable the user to manage wallet information stored on the external server.

(11) Response to Argument

First Issue

With regard to the first issue, appellant asserts that a prima facie case of obviousness has not been established by the examiner since there is no showing of proper motivation to combine the

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references cited. Appellant further states that neither Williams nor Teicher individually or in combination shows or suggests a hybrid virtual wallet system as claimed. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, with regard to claim 14, examiner relies on the disclosure of Williams et al that teaches the use of a local portion of a virtual wallet on a consumers desktop (Figure 2, 158; Col. 11, lines 54-56; Col. 12, lines 18-22 and 46-49; Col. 19, lines 43-49) and a server portion of a virtual wallet located on a bank's server wherein the server portion of the wallet contains a payment instrument such as a visa account and a certificate associated with the payment instrument (Figure 2, ref #160 and Figure 10, Ref#1040; Col. 11, lines 43-55) and exchanging first data from a local portion of the virtual wallet into a point of sale device wherein the first data includes a transactional amount (Figures 11-12 and 34; Col. 3, lines 1-8; Col. 11, lines 59-67; Col. 14, lines 5-11; Col. 18, lines 46-57). Williams et al further disclose that this method supports transactions such as checking out videos electronically via the Internet, originating sales for products and refund transactions (Col. 18, lines 55-67). Examiner concedes, however, that Williams et al fail to disclose synchronization between the local and server portions of the wallet by receiving and storing at the server portion an electronic voucher indicative of the good purchased and receiving a request for the electronic voucher at the server portion and providing the good to a user. *Teicher* discloses a system and method for making purchases with an electronic wallet that includes a local wallet portion (Figure 12, 9) and an associated server portion such as the consumers central account at a financial institution that is associated with the consumers electronic wallet (Figure 12, 381-384; Col. 7 line 60-Col. 8 line 3), and teaches receiving and storing at the server portion an electronic voucher indicative of the purchase and receiving a request for the electronic voucher at the server portion of the wallet (Col. 7 line 60-Col. 8 line 3; Col. 8, lines 9-14; Col. 9, lines 21-30; Col. 10, lines 3-8 and 15-32) and providing the good to a user upon receipt of the electronic voucher (Col. 11, lines 57-65).

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Appellant asserts that Teicher neither discloses receiving at the server portion of the wallet an electronic voucher indicative of the electronic good purchased at the point of sale device nor receiving a request for the electronic voucher and providing the electronic good to a user upon receipt of the electronic voucher. Examiner submits that Teicher discloses that transaction orders (vouchers) are received by transaction processing centers of the financial institution where the customer's server portion of the wallet is located (Col. 10, lines 5-20) and a request for the voucher (payment) is received from the merchant and payment is provided to the merchant (Col. 10, lines 20-28; Col. 18, lines 53-61 and Col. 21, lines 45-50). Examiner also submits that Teicher disclose that retail is a process involving payment against the supply of goods and/or services (Col. 1, lines 9-12), thus, it would have been obvious to one having ordinary skill in the art, that the goods would be provided to the customer after the transaction takes place in order to provide the customer with the goods that he/she paid for.

Furthermore, Teicher discloses both an electronic purse portion of the local wallet and an electronic checkbook portion of the local wallet wherein the electronic checkbook works in tandem with the consumer's central account at the consumer's financial institution to reconcile transactions made by the consumer with the electronic checkbook (Col. 9, lines 21-25; Col. 10, lines 20-32). Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Williams et al* and include the steps of synchronizing the local and server portions of the electronic wallet as taught by *Teicher*. The motivation for synchronizing the local and server portions of the wallet would be to ensure that the server portion of the wallet or the central consumer account associated with the local electronic wallet can be debited for purchases made off-line with the local electronic wallet so that both portions of the wallet ultimately reflect the same transactions and the same ending balance for the account. Teicher specifically indicates that the system operates to transfer a specified sum from a customer's account in a financial institution corresponding to the customer's electronic checkbook to the merchant's account when a checkbook payment is executed (Col. 9, lines 21-25; Col. 10, lines 20-28) suggesting that it is important to reconcile both registers or accounts when transactions are made using the electronic checkbook.

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Appellant further asserts that Williams et al fails to show the hybrid virtual wallet system as claimed and relies on appellant's specification that discloses "The local residence of the wallet may comprise...[a] device that enables the wallet to be utilized off-line. Typically, the local aspect of the virtual wallet, the local contents, comprises data and information determined by the wallet owner to be important, while the entire wallet is contained remotely". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., utilizing the local wallet off-line and the contents of the local wallet) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, independent claim 14 merely recites exchanging data from a local portion of the wallet into point of sale device which is not interpreted by the examiner as a suggestion of using the wallet off-line. Williams et al disclose using the local wallet for online purchases using a consumer's computer. Examiner interprets this method of conducting a transaction as constituting a point of sale device. The claim does not recite or suggest that the point of sale device is limited to traditional devices in a retail establishment.

Second Issue

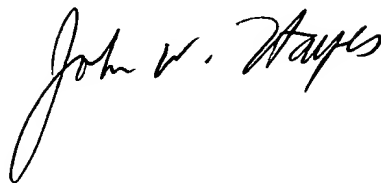
With regard to the second issue, appellant provides no further arguments with the exception of the argument stated above with respect to the non-establishment of a prima facie case of obviousness by the examiner which has been discussed above. With respect to the Biffar reference applied against claims 23 and 24 in combination with the Williams et al and Teicher references, Appellant has not provided specific disagreements with with examiner's contentions. Furthermore, appellant has not discussed the reference to Biffar applied against the claims, explaining how the claims avoid the references or distinguish from them.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

John W Hayes
Examiner
Art Unit 3621




December 4, 2002

Conferees

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